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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,262	03/23/2001	Michael D. Svoboda	OVTN-0001	7296

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EXAMINER	
SHANNON, MICHAEL R	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/816,262	SVOBODA, MICHAEL D.	
	Examiner	Art Unit	
	Michael R. Shannon	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-11,13-18 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-11,13-18 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 18 March 2005 have been fully considered but they are not persuasive.

Regarding the argument set forth on the 3rd line of page 9, the applicant states, "at the outset the Applicant respectfully calls the Examiner's attention to the fact that the Examiner has given no reason why a person of ordinary skill in the art would be motivated to combine the two cited references". This, in fact, is incorrect. The Examiner originally stated that distributing advertisements using the method and system disclosed by Hite to a cinema instead of a home would have been obvious for the reasons given in the original office action, more specifically, for eliminating the need of physical distribution of advertisements to cinemas and instead utilizing a server and a few regional areas for advertisement distribution to end-point theatres (see the rejection of claim 1 in the original office action dated 15 December 2004). For further clarification, the Examiner directs the attention of the Applicant to column 7, lines 16-21 of the Sharkey reference, wherein, the suggestion for motivation is expressly spelled out. The Sharkey reference states, "broadcast technologies could eventually eliminate physical distribution of film prints and trailers or advertisements before theaters, by having them sent and controlled from one main area or from a few regional areas". Therefore, the distribution of advertisements that is taught by the Hite reference could easily be combined with the Sharkey reference for the reasons discussed above and in the original rejection.

Regarding the argument set forth on the 8th line of page 9, the applicant states, "No specific reason has been set forth by the Examiner on why Hite is viewed as being analogous to the operation of a movie theatre". The examiner is not required to make this analogous argument. The operation of the Hite reference serves to distribute advertising to home users. The operation of the Sharkey reference is used to motivate the distribution of advertisements (using the system as disclosed by Hite) to cinemas and is therefore analogous for the aforementioned reasons.

Regarding the argument set forth on the 9th line of page 9, wherein the applicant states, "The Applicant respectfully suggests that the broadcasting business and the movie theatre business are separate and distinct disciplines." According to the Sharkey reference, this is not so. Column 7, lines 16-21 of the Sharkey reference make note of the fact that broadcast technologies would be useful in a theater environment and are therefore not separate and distinct disciplines. The Sharkey reference states, "broadcast technologies could eventually eliminate physical distribution of film prints and trailers or advertisements before theaters, by having them sent and controlled from one main area or from a few regional areas".

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine was given according to the knowledge generally available to one of ordinary skill in the art and in the Sharkey reference, column 7, lines 16-21 (see the arguments above).

The motivation to combine still stands, and therefore, the original rejection, as included below, with claims 5, 12, and 19 cancelled and rolled up into their respective independent claims 1, 8, and 15, is maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 6-11, 13-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al US patent 5,774,170, cited by examiner, in view of Sharkey US patent 5,026,152, cited by examiner.

Regarding claim 1, Hite et at disclose an advertising server that has a database of advertisements [Fig. 2 & col. 8, line 65 – col. 9, line 12]. Hite et al further disclose a distribution controller, associated with the advertising server that causes selected ones of the advertisements to be communicated from the advertising server via a network and displayed [col. 9, lines 32-37]. Hite et al do not disclose the plurality of

geographically distributed displays, associated with a corresponding plurality of theatres and coupled via a network to the advertising server, nor do they teach that the distribution controller communicates the advertisements to the displays located at theatres. Sharkey discloses a system for receiving programming/advertisements [col. 1, lines 9-11] at the theatre and distributing (with optional special effects) the programming/advertisements to a plurality of displays. The claimed plurality of geographically distributed displayed, associated with a corresponding plurality of theatres and coupled via a network to the advertising server is met by the discussions in column 2, line 68 – column 3, line 2 and column 6, lines 25 – 33. Regarding the elements that were rolled up into claim 1 from cancelled claim 5, the claimed plurality of geographically distributed displays each comprising a local storage unit that locally stores selected ones of advertisements is met by the Optional Video Storage Device 456 [Fig. 5], described in column 14, lines 28-46. It would have been obvious to one of ordinary skill in the art at the time of the invention to distribute advertisements to a theatre environment instead of distributing to home users, in order to allow for consumer directed ads during, before, and after related movies at theatres, with the added benefit of eliminating physical distribution, and instead utilizing a server area and a few regional areas for advertisement distribution to end-point theatres.

Regarding claim 2, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 1. Hite et al do not disclose that the video projectors are adapted to display advertisements on corresponding movie screens of the theatres. Sharkey, however, does disclose that projectors are used to display the

movie/advertisement [col. 6, lines 25-33]. It would have been obvious to one of ordinary skill in the art at the time of the invention to display the advertisements on projector systems, in order to allow standard theatres to display the ads on movie screens concurrently or significantly concurrently with the movie or movie trailers.

Regarding claim 3, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 1. The Hite reference further discloses that the displays can include video monitors [Abstract]. The Hite reference does not expressly point out that the video monitors can be located in the theatres. The Sharkey reference, however, teaches that the advertisements are delivered to a plurality of theatres. It would have been obvious to one of ordinary skill in the art at the time of the invention to deliver the advertisements to video monitors within the theatres, in order to allow users who are not currently viewing a movie to watch advertisements on shared video monitors, as is well known in the art.

Regarding claim 4, the claimed advertisements being selected from the group consisting of: static, picture-in-picture, audio, animation, multi-segment, and full-motion video clips is met by the discussion of audio or video advertisement clips selectable from the Ad database [col. 10, lines 54-61].

Regarding claim 6, the claimed distribution controller comprising a reporting module that maintains a distribution history for the selected ones of the advertisements is met by the discussion of upstream transmission to notify the head-end of executed

and/or stored advertisements, in order to maintain a distribution history [col. 5, lines 7-27].

Regarding claim 7, the claimed distribution controller comprising a copy module that allow remote advertisers to provide new advertisements to the database is met by the discussion of the reporting agencies that create and send the new commercials to the Ad Administration Facility [col. 9, lines 2-12].

Regarding claim 8, Hite et at disclose the step of storing a plurality of advertisements in a database of advertisements associated with an advertising server [Fig. 2 & col. 8, line 65 – col. 9, line 12]. Hite et al further disclose the step of causing selected ones of the advertisements to be communicated from the advertising server via the network and displayed [col. 9, lines 32-37]. Hite et al do not disclose the step of coupling a plurality of geographically distributed displays, associated with a corresponding plurality of theatres, to the advertising server via a network, nor do they teach that the distribution controller communicates the advertisements to the displays located at theatres. Sharkey discloses receiving programming/advertisements [col. 1, lines 9-11] at the theatre and distributing (with optional special effects) the programming/advertisements to a plurality of displays. The claimed plurality of geographically distributed displayed, associated with a corresponding plurality of theatres and coupled via a network to the advertising server is met by the discussions in column 2, line 68 – column 3, line 2 and column 6, lines 25 – 33. Regarding the elements that were rolled up into claim 8 from cancelled claim 12, the claimed plurality of geographically distributed displays each comprising a local storage unit that locally

stores selected ones of advertisements is met by the Optional Video Storage Device 456 [Fig. 5], described in column 14, lines 28-46. It would have been obvious to one of ordinary skill in the art at the time of the invention to distribute advertisements to a theatre environment instead of distributing to home users, in order to allow for consumer directed ads during, before, and after related movies at theatres, with the added benefit of eliminating physical distribution, and instead utilizing a server area and a few regional areas for advertisement distribution to end-point theatres.

Regarding claim 9, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 8. Hite et al do not disclose that the video projectors are adapted to display advertisements on corresponding movie screens of the theatres. Sharkey, however, does disclose that projectors are used to display the movie/advertisement [col. 6, lines 25-33]. It would have been obvious to one of ordinary skill in the art at the time of the invention to display the advertisements on projector systems, in order to allow standard theatres to display the ads on movie screens concurrently or significantly concurrently with the movie or movie trailers.

Regarding claim 10, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 8. The Hite reference further discloses that the displays can include video monitors [Abstract]. The Hite reference does not expressly point out that the video monitors can be located in the theatres. The Sharkey reference, however, teaches that the advertisements are delivered to a plurality of theatres. It would have been obvious to one of ordinary skill in the art at the time of the invention to deliver the advertisements to video monitors within the theatres, in order to

allow users who are not currently viewing a movie to watch advertisements on shared video monitors, as is well known in the art.

Regarding claim 11, the claimed advertisements being selected from the group consisting of: static, picture-in-picture, audio, animation, multi-segment, and full-motion video clips is met by the discussion of audio or video advertisement clips selectable from the Ad database [col. 10, lines 54-61].

Regarding claim 13, the claimed step of maintaining a distribution history for the selected ones of the advertisements is met by the discussion of upstream transmission to notify the head-end of executed and/or stored advertisements, in order to maintain a distribution history [col. 5, lines 7-27].

Regarding claim 14, the claimed step of allowing remote advertisers to provide new advertisements to the database is met by the discussion of the reporting agencies that create and send the new commercials to the Ad Administration Facility [col. 9, lines 2-12].

Regarding claim 15, Hite et al meet certain parts of the claim as follows:

- The claimed advertising server having a database of advertisements and coupled to the computer network is met by the Ad Administration Facility 100 [Fig. 2], which is coupled to the network through connection 105.
- The claimed advertising controller coupled to the computer network that: (1) allows advertisers to provide advertisements to the database, (2) allows advertisers to specify distribution of the advertisements among the

theaters, (3) causes selected ones of the advertisements to be communicated from the advertising server via the network and displayed, and, (4) maintains a distribution history for the selected ones of the advertisements to allow the advertisers to be charged for the distribution is met by the Ad Administration Facility 100 [Fig. 2]. The Ad Administration Facility allows suppliers to provide ads to the database [col. 9, lines 2-12]. It further allows advertisers to specify distribution of the advertisements [col. 10, lines 54-61]. The Ad Administration Facility also causes the selected ones of the advertisements to be communicated from the advertising server via the network and displayed [col. 9, lines 32-37]. Finally, the Facility maintains a distribution history for the selected ones of the advertisements to allow the advertisers to be charged for the distribution [col. 5, lines 7-27].

- Regarding the elements that were rolled up into claim 15 from cancelled claim 19, the claimed plurality of geographically distributed displays each comprising a local storage unit that locally stores selected ones of advertisements is met by the Optional Video Storage Device 456 [Fig. 5], described in column 14, lines 28-46.

Hite does not disclose the following:

- A computer network being used in place of the discussed satellite network.

- A plurality of geographically distributed displays, associated with a corresponding plurality of theatres and coupled to the computer network.

Sharkey discloses receiving programming/advertisements [col. 1, lines 9-11] at the theatre and distributing (with optional special effects) the programming/advertisements to a plurality of displays.

- The claimed computer network is met by the discussion of the communication between two points [col. 6, lines 25-33].
- The claimed plurality of geographically distributed displayed, associated with a corresponding plurality of theatres and coupled to the computer network is met by the discussions in column 2, line 68 – column 3, line 2 and column 6, lines 25 – 33.

It would have been obvious to one of ordinary skill in the art at the time of the invention to distribute advertisements to a theatre environment over a computer network instead of distributing to home users, in order to allow for consumer directed ads during, before, and after related movies at theatres, with the added benefit of eliminating physical distribution, and instead utilizing a server area and a few regional areas for advertisement distribution to end-point theatres through a computer network.

Regarding claim 16, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 15. Hite et al do not disclose that the video projectors are adapted to display advertisements on corresponding movie screens of

the theatres. Sharkey, however, does disclose that projectors are used to display the movie/advertisement [col. 6, lines 25-33]. It would have been obvious to one of ordinary skill in the art at the time of the invention to display the advertisements on projector systems, in order to allow standard theatres to display the ads on movie screens concurrently or significantly concurrently with the movie or movie trailers.

Regarding claim 17, the Hite et al and Sharkey references disclose all that which is discussed above with regards to claim 15. The Hite reference further discloses that the displays can include video monitors [Abstract]. The Hite reference does not expressly point out that the video monitors can be located in the theatres. The Sharkey reference, however, teaches that the advertisements are delivered to a plurality of theatres. It would have been obvious to one of ordinary skill in the art at the time of the invention to deliver the advertisements to video monitors within the theatres, in order to allow users who are not currently viewing a movie to watch advertisements on shared video monitors, as is well known in the art.

Regarding claim 18, the claimed advertisements being selected from the group consisting of: static, picture-in-picture, audio, animation, multi-segment, and full-motion video clips is met by the discussion of audio or video advertisement clips selectable from the Ad database [col. 10, lines 54-61].

Regarding claim 20, the claimed advertising controller causing the selected ones of the advertisements to be communicated from the advertising server based on: time of day, day of week, season, movie screen sizes in the theatres, and ratings of motion

pictures playing in the theatres is met by the discussion of the codes indicating the conditions and rules required to display the commercial on column 7, lines 7-11.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon who can be reached at (571) 272-7356 or Michael.Shannon@uspto.gov. The examiner can normally be reached by phone Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

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Knox Building
501 Dulany Street

Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
June 14, 2005

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600